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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/986,305	11/08/2001	Bruno Borsoi	P21570	5187

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GREENBLUM & BERNSTEIN, P.L.C.
1950 ROLAND CLARKE PLACE
RESTON, VA 20191

EXAMINER

PHAM, HUONG Q

ART UNIT PAPER NUMBER

3743

DATE MAILED: 08/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/986,305

Applicant(s)

BORSOI, BRUNO

Examiner

Huong Q. Pham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 May 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13-23 and 25-47 is/are pending in the application.
- 4a) Of the above claim(s) 10-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 13-23, 25-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear if the recitations “ “ means for allowing bending”, “ one abutment” , and “ means for limit bending” refer to the same structure or different structure. The use of different terms to refer to an element is confusing and not acceptable in a claim.

Claims 2-9, 13-18, 41, 44 are objected as being dependent on rejected claim 1.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1, 8-9 ,13-14, 16 , 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Dachgruber et al (6,360,454).

As for claim 1, Dachgruber et al shows every claimed feature of the claim including a rigid frame 24 adapted to cover the joint, said rigid frame comprising means 98 or 100 (note the edges of references 100, 98, and note that the frame 24 can be bent at a predetermined angle where opposed edges of structure 100, 98 will limit some degree further bending of the frame and joint. Note that the apertures 100 or the notches 98 have abutting surfaces :abutting surfaces are the side-edges of apertures 100 or of notches 98 , and when the device 24 of Dachgruber et al is flexed at some degree, the abutting surfaces or edges are capable of having the function to limit flexion to some degree) for allowing bending of the protective article and bending of the joint along at least one bending direction through a predetermined angle of bending (the angle of bending can be determined by a user) , said means comprising at least one bending zone between opposed ends of the frame, said bending zone including at least one abutment 98 or 100 with opposed edges, said opposed edges being spaced apart a

predetermined amount in a first and unbent position of the protective article and spaced apart by an amount less than said predetermined amount in a second and bent position of the protective article, in said second and bent position of the protective article, said abutment of said means for allowing bending comprising means for limiting bending of the frame and limiting bending of the joint along said bending direction at said predetermined angle of bending, said rigid frame having a rigidity of a magnitude to avoid hyper- flexion of the joint beyond said predetermined angle of bending while the protective article is in said second and bent position. As for claim 13, note the cooperating mechanism 45 or 90 or 50. As for claim 16, note that the user of Dachgruber et al 's protective article is capable of performing a predetermined angle of between 30 and 45 degree. As for claim 18, note in figure 3, membrane 30 with fixing means 50 , and note column 4, lines 12-16.

Claims 1-5, 8-9, 14, 18, are rejected under 35 U.S.C. 102(b) as being anticipated by Rathmell (4,043,059)).

As for claim 1, Rathmell shows every claimed feature of the claim including a rigid frame 4, 5 adapted to cover the joint, said rigid frame comprising means 4, 5, and the stiffening member of figure 4 for allowing bending of the protective article and bending of the joint along at least one bending direction through a predetermined angle of bending (the angle of bending can be determined by a user) , said means comprising at least one bending zone between opposed ends of the frame, said bending zone

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including at least one abutment 5 with opposed edges, said opposed edges being spaced apart a predetermined amount in a first and unbent position of the protective article and spaced apart by an amount less than said predetermined amount in a second and bent position of the protective article, in said second and bent position of the protective article, said abutment of said means for allowing bending comprising means for limiting bending of the frame and limiting bending of the joint along said bending direction at said predetermined angle of bending, said rigid frame having a rigidity of a magnitude to avoid hyper- flexion of the joint beyond said predetermined angle of bending while the protective article is in said second and bent position. As for claim 2, note figure 1. As for claims 3, 18, note membrane 1, 2 in figure 1. As for claim 4, note the insert in figure 4. As for claim 5, the supports in figure 1.

Claims 1- 9, 14, 17-23, 25-47 are rejected under 35 U.S.C. 102(b) as being anticipated by Rathmell (3,968,578).

As for claim 1, Rathmell shows every claimed feature of the claim including a rigid frame 8 adapted to cover the joint, said rigid frame comprising means for allowing bending of the protective article and bending of the joint along at least one bending direction through a predetermined angle of bending (the angle of bending can be determined by a user) , said means comprising at least one bending zone between opposed ends of the frame, said bending zone including at least one abutment with opposed edges, said opposed edges being spaced apart a predetermined amount in a first and unbent position of the protective article and spaced apart by an amount less

than said predetermined amount in a second and bent position of the protective article, in said second and bent position of the protective article, said abutment of said means for allowing bending comprising means for limiting bending of the frame and limiting bending of the joint along said bending direction at said predetermined angle of bending, said rigid frame having a rigidity of a magnitude to avoid hyper- flexion of the joint beyond said predetermined angle of bending while the protective article is in said second and bent position. As for claim 3, note membrane 2, 1. As for claims 4, 22, note the compressible material 5. As for claim 5, note that Ramell teaches the recited supports. As for claims 6,7, note envelope 1, 2, pockets 5, 8, and shock absorbing element 5 . As for claim 40, note the tongue 5. As for claim 47, note that the device is capable of providing a range of bending with the angle movement of no greater than 45 degrees.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13, 15, 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rathmell (3,968,578).

As for claims 13 and 15, the provisions for boot tightening means, cooperating mechanism and/or a recess in an area for accommodating toes of a wearer are well-known and well within the realm of one ordinary skill in the art. Therefore, it would have been obvious to one ordinary skill in the art at the time the invention was made to provide these structure to any boot for fastening or ventilation purpose. As for claim 16, note that a user of Rathmell device is capable of performing at the recited range of angle as recited.

Applicant's arguments filed on 5/25/2006 have been fully considered but they are not persuasive.

Note the comments and explanation relative to the claims above. Note the comments relative to the claims above for the teaching of Dachgruber (note abutment 100, 102, or 98 of Dachgruber et al). Note that the edges of the apertures 100, or the edges of the notches 98 have abutting surfaces, and when the device 24 of Dachgruber et al is allowed to flex, the edges of the apertures or notches are abutted and therefore are capable of having the function of limiting or resisting flexion to some degree (note that in claim 1, the range of bending or angle is not recited). Note column 4, lines 11-16 of Dachgruber et al (the recess 40 may be made substantially the same size as the tongue stiffener), and note that the frame or stiffener 24 is fixed to the base by hook 50.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huong Q. Pham whose telephone number is (571) 272-4980. The examiner can normally be reached on 8:45 AM - 5:15 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Bennett can be reached on (571) 272 - 4791. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

August 17, 2006

A handwritten signature in black ink, reading "Michael A. Brown". The signature is written in a cursive, flowing style.

**MICHAEL A. BROWN
PRIMARY EXAMINER**